

disclose a “third embodiment.” (*Restriction Requirement, Page 2*).

A Restriction Requirement must provide the particular factual basis for asserting that restriction is necessary. In particular, the “particular reasons ... for holding that the inventions as claimed are either independent or distinct should be concisely stated.” (*MPEP § 816*). A “mere statement of conclusion” is inadequate. (*MPEP § 816*). Moreover, in making a restriction, it is the “claimed subject matter that is considered,” and the claimed subject matter “must be compared in order to determine the question of distinctness or independence.” (*MPEP § 806.01*).

The Restriction Requirement contains absolutely no analysis of the “claimed subject matter.” The Restriction Requirement instead focuses on the drawings and asserts that the drawings disclose multiple embodiments. MPEP § 806.01 requires a comparison of the claimed subject matter to be performed when making a restriction, not a comparison of the drawings. By failing to perform any kind of analysis regarding the claims, the Patent Office fails to meet its burden in making the restriction.

Also, the Restriction Requirement contains absolutely no “particular reasons” for holding that the claimed inventions are distinct. The Restriction Requirement simply makes an unsupported assertion that the drawings disclose patentably distinct species. MPEP § 816 requires that the Patent Office provide particular reasons for making a restriction. By failing to explain how or why the drawings disclose patentably distinct species, the Patent Office fails to meet its burden in making the restriction.

In addition, the Restriction Requirement again incorrectly asserts that there is no “generic

claim” pending in this application. Claims 1 and 17 are both generic claims for the various “embodiments” illustrated in the Applicants’ drawings. In particular, both Claims 1 and 17 are generic claims for the embodiments shown in Figures 1A-1F (and Figures 2A-2C, which are extensions of the embodiment shown in Figures 1A-1F), Figures 3A-3G, and Figures 4A-4F.

Figures 1A-1F illustrate how a circuit may be formed, which includes forming layers 2 and 4 on a substrate 1. Figures 3A-3G illustrate how the layer 2 could be formed on layer 2a, rather than on the substrate 1. However, after layer 2 is formed on layer 2a, layer 4 is formed on layer 2 in the same way shown in Figures 1D-1E. (*Application, Page 21, Lines 20-23*). Figures 4A-4F illustrate how an additional layer 2B may be formed on layer 4. While Figures 1A-1F illustrate the use of polishing to remove certain elements (inserts 12), Figures 4A-4F illustrate how the inserts 12 may be removed by etching. (*Application, Page 13, Line 31 – Page 14, Line 29; Page 22, Line 29 – Page 23, Line 8*).

Claims 1 and 17 cover all three of these embodiments. For example, Claim 1 recites forming, covering, polishing, and removing steps in a first “layer treatment.” The forming, covering, polishing, and removing steps recited in Claim 1 cover all three embodiments shown in Figures 1A-1F, Figures 3A-3G, and Figures 4A-4F. Nothing in Claim 1 limits Claim 1 to only one embodiment shown in Figures 1A-1F, Figures 3A-3G, or Figures 4A-4F. Similarly, Claim 1 recites forming, covering, and partially removing steps in a second “layer treatment.” Again, the forming, covering, and partially removing steps recited in Claim 1 cover all three embodiments shown in Figures 1A-1F, Figures 3A-3G, and Figures 4A-4F. Nothing in Claim 1 limits Claim 1 to only one embodiment

shown in Figures 1A-1F, Figures 3A-3G, or Figures 4A-4F.

The Patent Office has twice failed to analyze the claimed subject matter, provide an explanation as to how the claims recite patentably distinct species, or provide an explanation as to why Claims 1 and 17 are not generic claims. As a result, the Patent Office has once again failed to satisfy the requirements for restricting the claims of this patent application. Accordingly, the Applicants respectfully request that the restriction be withdrawn.

SUMMARY


If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: June 27, 2008

  
\_\_\_\_\_  
William A. Munck  
Registration No. 39,308

P.O. Drawer 800889  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: *wmunck@davismunck.com*